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NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			EXAMINER LEIVA, FRANK M	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/621,152
Filing Date: July 15, 2003
Appellant(s): THOMAS, ALFRED

Wayne L. Tang
Reg. No. 36,028
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 February 2010 appealing from the Office action mailed 16 September 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 3-7, 11-23, 25, 26 and 30 are still rejected and pending.

(4) Status of Amendments after Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal.

Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2005/0014548	Thomas	01-2005
2004/0062025	Satoh et al.	04-2004
5,722,891	Inoue	03-1998
2003/0022713	Jasper et al.	01-2003
6,702,675	Poole et al.	03-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. **Claims 1, 3-6, 11-15, 18-20, 22-23, 25-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh et al. (US 2004/0062025 A1) in view of Inoue (US 5,722,891) and further in view of Jasper et al. (US 2003/0022713 A1).**
3. Regarding the analogous art combination; Satoh discloses a single set of reels with modified appearance when playing a bonus game or special feature game; Inoue discloses changing the appearance of the reels during a bonus game even when the bonus game is played in a different set of reels, to push the players attention to the second set of reels; and Jasper discloses a single set of reels game that has a bonus game using the same reels to generate a Bonus playing scheme with different odds from the Base game.
4. **Regarding claims 1 and 30;** Satoh discloses a method for changing an appearance of a plurality of mechanical reels device displayed on a gaming machine, ([0001] and [0007]);

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the method comprising receiving a wager to play a base wagering game that utilizes the mechanical reels, (¶ [0001-0002]) where Slot machines are well-known casino games that require a wager to play a base game;

detecting an indication to play a special feature game that utilizes the mechanical reels device, (¶ [0054]) where the system changes color in response to a change to bonus game it is inherent that the system also detect the indication to play the special feature game (bonus game); and

in response to detecting the indication, changing an appearance of the mechanical reels prior to playing the special feature game to provide visual notification to a player that the special feature game is underway rather than the base wagering game (¶ [0054]);

Satoh is silent to the change of appearance being maintained during the bonus round or game and although one of ordinary skill would think to do so, Inoue discloses the changed appearance of the mechanical reels being maintained while the special feature game is played, (col. 3:41-48), where the indicator is on during the bonus game, making it more conspicuous.

It would have been obvious to modify Satoh by maintain the color change indication of the reels during the bonus round as shown in Inoue to show the player that he/she are still playing the bonus round and the game has not resumed.

Satoh also fails to disclose having different odds for the base game and bonus game, whereas Jasper discloses the base wagering game having a first mathematical model of player odds (first set of odds), the outcomes of the player odds displayable on the mechanical reels (claim 1 line 3-6); and the special feature game having, a second mathematical model of player odds (second set of odds), the outcomes of the player odds displayable on the mechanical reels (claim 1 line 7-12), and the second mathematical model being different from the first mathematical model (claim 3).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Satoh by having different sets of mathematical models

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for the Bonus and Base games to increase player retention on the game as taught by Jasper. The higher odds on the Bonus game, yields higher prizes for the players.

5. Regarding claims 3 & 25; Satoh further discloses wherein the special feature game comprises a bonus game, (¶ [0054]).

6. Regarding claims 4 & 26; Satoh, Inoue and Jasper discloses all the limitations of claims 1 and 20 from which claims 4 and 26 depend, and Inoue further discloses wherein the special feature game (bonus game) comprises a secondary game requiring an additional wager (claim 8). It would have been obvious try after combining Satoh with Inoue; to modify Satoh, Inoue and Jasper with the additional wager of Inoue for the bonus round in order to entice the player into further bets.

7. Regarding claims 5 & 14; Satoh further discloses wherein changing the appearance comprises illuminating an illumination source of the gaming machine, (¶ [0054]).

8. Regarding claims 6, 15 and 22; Satoh further discloses wherein the illumination source is selected from the group consisting of black-light, colored light emitting diodes, white light emitting diodes, organic light emitting diodes, incandescent bulbs, colored film in conjunction with incandescent bulbs and colored film in conjunction with light emitting diodes, (¶ [0054]).

9. Regarding claims 11 & 18; Satoh further discloses wherein the first and second indications are based on a selection by a player, (¶ [0004-0005]), wherein the illumination is dependent on the amount of coins (paylines selected) wagered by the player.

10. Regarding claims 12 & 19; Satoh further discloses wherein the indication is based on a triggering event occurring during base wagering game play (slot game), (¶

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[0004-0005]), wherein the illumination is triggered by the symbols stopping on the active paylines.

11. Regarding claim 13; Satoh further discloses a method for changing an appearance of a plurality of mechanical reels on a gaming machine, the method comprising: receiving a wager to play a slot game that utilizes the plurality of mechanical reels; detecting a first indication to play a bonus game that utilizes the plurality of mechanical reels; in response to detecting the first indication, changing a color of the plurality of mechanical spinning reels prior to playing the bonus game and maintaining the changed color of the plurality of mechanical spinning reels during the playing of the bonus game; detecting a second indication to terminate play of the bonus game; and in response to detecting the second indication, restoring the color to the plurality of mechanical spinning reels, (¶ [0054]), the indication of transition means that prior to the bonus stage starting the colors are changing, the implication of a transition means that the colors will remain during the bonus and change back, (another transition to normal).

12. Regarding claim 20; Satoh further discloses a gaming machine comprising: a value input device; a displayed plurality of mechanical reels operable during both a base game and a special feature game; an illumination source adapted to illuminate the displayed mechanical reels device; and a controller operatively coupled to the value input device, the displayed mechanical reels and the illumination source, the controller comprising a processor and a memory coupled to the processor, the controller being programmed to allow a player to make a wager to play the base game, detect a first indication to play the special feature game, and in response to detecting the first indication, illuminate the illumination source to change an appearance of the displayed mechanical reels prior to playing the special feature game to provide visual notification to a player that the special feature game is underway rather than the base game and the changed appearance of the mechanical reels is maintained while the special feature game is played, (¶ [0001-0004 and 0054]),], the indication of transition means that

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prior to the bonus stage starting the colors are changing, the implication of a transition means that the colors will remain during the bonus and change back, (another transition to normal).

13. Regarding claim 23; Satoh further discloses wherein the change to the appearance of the displayed mechanical reels comprises a color change to the displayed mechanical reels, (¶ [0054]).

14. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh, Inoue and Jasper in further view of Poole et al. (US 6,702,675 B2).

15. Regarding the analogous art combination; Poole teaches an image super-imposition over video reels that although it is done in a video display, the three dimensional aspect of the image teaches any overlaying graphics display that it would be an ideally visual effect.

16. Regarding claims 7 & 17; Satoh, Inoue and Jasper disclose all the limitations of claims 1 and 13 which claims 7 and 17 depend, and Poole discloses in Fig. 4 and 5 of his invention, wherein changing the appearance comprises overlaying a video image upon the mechanical reels, wherein Poole is a video slot game, still it represents the image as if overlaid on the virtual reels. The examiner points to the simple nature of overlaying a picture in front of the reels after viewing Poole, it would not be an invention but a simple incorporation of Poole and would yield the predictable result.

17. Claims 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh, Inoue and Jasper in further view of Official Notice.

18. Regarding claims 16 and 21; Satoh discloses changing colors to mark the transition to a bonus feature, and or to mark any change in game state including the termination of the bonus feature, (¶ [0001 and 0054]), yet Satoh fails to mention de-

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illumination as an indication where the examiner states as admitted prior art that the color remaining by not illuminating an object is the same as a change of color, as simple as black being the absence of color yet a color in itself, so is the illumination with a colored light and de-illuminating it would constitute a change in color and thus disclose in Satoh though not explicitly is, in response to detecting the second indication, de-illuminate the illumination source to restore the appearance of the displayed mechanical reels.

19. Regarding the examiner's assertion of Official Notice; the examiner deems the Official Notice asserted in the previous action as admitted prior art since there was no contest or traverse raised in applicant's response to the action. Please see MPEP 2144.03.

(10) Response to Argument

All of the Exhibits filed after Notice of Appeal have been considered. It should be noted that these "Exhibits" are merely copy of references and office action.

In regards of appellant's argument section A; Group 1: The appellant has argued that the claims solve different problems inherent in the gaming mechanisms of Inoue and Jasper with Satoh and combining Inoue and Jasper with Satoh would be a change in the fundamental operation of Satoh.

The examiner's position is simply: whether the combination of Satoh, Inoue and Jasper is proper.

Satoh's invention is a simple window frame illuminating device to indicate to the player the changes in game state. Satoh implements this invention for the preferred embodiment of a 3 reels slot machine window, disclosing the particulars of the gaming machine only for the purpose of showing how the devices can be used. Satoh does

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disclose the reels will serve to play the base game and the bonus game and the lighting devices will differentiate the state of the game (normal play or bonus play) in paragraph [0058]. Satoh also describes the process of indicating a transition time between the playing of the base game to the playing of the bonus game, in which the color indications create stage effects to indicate the change of state responsive to the stage of the game.

Appellant's argument A1 (a) is directed to Inoue's invention having a separate set of reels to play the bonus round, and thus it cannot teach Satoh without destroying Satoh. The examiner traverses this argument by pointing out that the entire disclosure of Inoue is not being incorporated into Satoh, only the teaching that the lighting effects during the bonus round are maintained in an "on" state during the execution of the bonus round for the purpose of making it more conspicuous to the player. This teaching is irrelevant of the number of reel sets, just as long as it is the reels which are being played, are the ones being indicated. In short, since the bonus round has to be indicated as the appellant pointed out in page 9 lines 12-13 of the brief, "*Gaming regulations require that a player is notified of a change between that base game and the special feature game*", and Inoue discloses a continued color change while playing the bonus game, Satoh's invention only having one set of reels would have obviously held the color changes throughout the bonus game as well.

Appellant's arguments A1 (b) and Section A; Group 4 are directed towards Jasper not disclosing using the same reels for the base and bonus, For which the examiner traverses by pointing out Jasper's claim 1 in which includes a single set of

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reels from which that base and bonus games use a first and second subset of reels where both subsets could be the complete set of reels according to claims 5 and 6.

Appellant's argument A1 (c) is directed towards Satoh's lack of communicating that the base and bonus games have a different set of odds or mathematical models. For which the examiner agrees and is dependent on the combination with Jasper to show that a game with a single set of reels can have different odds for the base and bonus games, (Jasper claim 3).

In regards to appellant's argument Section A; Group 2; The appellant argues that combining Inoue with Satoh would destroy Satoh, but as explained earlier, Inoue's teaching of indication the stage of game play to the player to avoid confusion only fortifies Satoh to maintain the color changes while playing the bonus game, since it is the only manner in which to differentiate play when using the same set of reels.

In regards of appellant's argument Section A; Group 3; the appellant argues that the combination of Jasper and Inoue with Satoh would destroy Satoh's invention, both arguments commented above would not change Satoh's intended purpose of indicating the progression of state from a base game to a bonus game by changing the illumination of the reels, nor would having a different set of odds for the bonus game would change Satoh's illumination system.

In regards of appellant's argument sections B and C: The appellant argues the allowability of the dependent claims by association to the independent claims, since the independent claims rejections are being held, so are the dependent claims.

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For the reasons stated above the examiner deems the arguments not persuasive and the rejections are maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Frank M Leiva/

Examiner, Art Unit 3714

Conferees:

/Peter D. Vo/

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